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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,740	05/18/2000	Michael S. South		9926

7590 01/20/2004  
Senniger, Powers, Leavitt & Roedel  
One Metropolitan Square  
16th Floor  
St. Louis, MO 63102

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/574,740

**Applicant(s)**

SOUTH ET AL.

**Examiner**

Tamthom N. Truong

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-24, 33-40 and 46-57 is/are pending in the application.
- 4a) Of the above claim(s) 33-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-23 is/are allowed.
- 6) ☒ Claim(s) 24 is/are rejected.
- 7) ☒ Claim(s) 46-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicants' election of group I (as presented in the Restriction Requirement) is acknowledged. Claims 17-24 (in part), and 46-57 (in part) are pending while claims 33-40 are withdrawn herein as being drawn to the non-elected subject matter. Claims 25-32, and 41-45 have been cancelled.

Applicants request to expand the original group I to include Q representing a heteroaryl group, and Y representing thiophene, oxazole, furan, pyrrole, imidazole, or pyrazole. That is, the new group I would combine the original groups I, V, VI, and X. However, the search for the new group I would be extensive since Q would represent essentially any ring, and Y would be (practically) any monocyclic system. Thus, it leads to a broad search of -NH-pyridinone-(N-CH<sub>2</sub>-C(=O)-NH). Such a search would yield too large a hit, and a relevant prior art could easily be missed. Furthermore, if Q was to represent any ring, then the subject matter would also be classified in other classes and subclasses as well (e.g., 544, 540, 546, etc.). Therefore, the combination of the original groups I, V, VI, and X would pose a serious burden of searching and examining.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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1. Claim 24 recites the substituent of "6-amidocarbonylhexyl" in some species. There is insufficient antecedent basis for this limitation in the claim. The term "amidocarbonyl" suggests an additional carbonyl group (or  $-C(=O)$ ), which does not have antecedent basis in claim 17. In claim 17, the alkyl group (represented by B) can be substituted with "carboxamido", and not "amidocarbonyl". The group "carboxamido" is not the equivalent of "amidocarbonyl".

#### ***Claim Objections***

2. Claims 46-57 are objected to under 37 CFR 1.75(c) as being in improper form because they depend on either claim 40, or claims 33-39 which are held withdrawn. See MPEP § 608.01(n). Accordingly, the claims 46-57 have not been further treated on the merits.

#### ***Allowable Subject Matter***

3. Claims 17-23 (in part) are allowable. As far as the elected group I is concerned, there is no prior art teaching the combination of an aryl group (i.e., Q) with phenyl, benzyl, pyridyl, or pyridylmethyl (i.e., Y<sup>0</sup>).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9 am - 5:30 pm) starting from January 12<sup>th</sup>, 2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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January 14, 2004



Richard L. Raymond  
Acting SPE  
Art Unit 1624